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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

YOR920030013US1

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on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed  
name \_\_\_\_\_

Application Number

10/680,260

Filed

October 8, 2003

First Named Inventor

David Abraham

Art Unit

2814

Examiner

Ahn D. Mai

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 48,317

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_



Signature

Scott M. Tulino, Esq.

Typed or printed name

703-761-4100

Telephone number

February 28, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

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\*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Serial No. 10/680,260  
Docket No. YOR920030013US1

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**In re Application of**

David Abraham et al.

**Serial No.:** 10/680,260

**Group Art Unit:** 2814

**Filed:** October 8, 2003

**Examiner:** Mai, Anh D.

**For:** METHOD AND SYSTEM FOR PATTERNING OF MAGNETIC THIN FILMS  
USING CHEMICAL TRANSFORMATION

Honorable Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
**Box AF**

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

Prior to developing a formal Appeal Brief, Appellants submit the following argument for review by more experienced Examiners under the pilot Pre-Appeal Brief Conference. Appellants concurrently file herewith a Petition for Extension of Time, for a one-month extension of time, and a Notice of Appeal.

Appellants hereby request that the Conference attendees refer to the full argument of Appellants on pages 2-9 of the Response filed Under 37 C.F.R. § 1.116, filed on December 28, 2005, and do not herein repeat these arguments in their entirety.

In addition to these arguments, Appellants respectfully submit that claim 1 does not recite "producing a magnetic device", as alleged by the Examiner. Indeed, claim 1 clearly recites "a method of patterning a magnetic thin film". Claim 13 further limits the subject matter of claim 1 by claiming the additional step of producing a magnetic device

after the limitation of “transforming a portion of the magnetic thin film to be non-magnetic and electrically insulating using a chemical formation”.

Furthermore, Appellants respectfully submit that the Examiner’s allegation that the rule § 1.131 Declaration is ineffective, is clearly erroneous. First, the Examiner has clearly failed to establish that Klemmer and Grynkewich claim the rejected invention. Indeed, the claimed invention of Klemmer is directed to a completely different statutory class of invention from the claimed invention of claims 1-26 of the Application. Furthermore, nowhere has the Examiner pointed out which claims of the Klemmer and Grynkewich claim the same invention of each of claims 1-26 of the claimed invention of the Application.

Second, Appellants submit that there is no requirement for Appellants to provide evidence that a working device is made. To establish an actual reduction to practice, the evidence provided only needs to show that Applicants performed a process that met every element of the claimed process.

Thus, the Declaration filed on August 23, 2005 is clearly effective to overcome the Examiner’s prior art rejections based on Kamata, Klemmer and Grynkewich and the Examiner’s failure to consider and enter the Declaration is clearly in error.

Regarding the Examiner’s 35 U.S.C. § 102(b), § 102(e) and § 103(a) rejections, Appellants submit that the Kamata, Klemmer and Grynkewich references are removed as prior art references by the entering of the Declaration. Thus, the Examiner has clearly failed to establish a *prima facie* case of anticipation or obviousness.

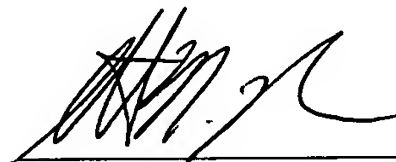
In view of the foregoing arguments, along with those arguments currently of record in the Response Under 37 C.F.R. § 1.116 filed on December 28, 2005, Appellants

submit that the prior art rejections currently of record fail to meet the Examiner's initial burden of a *prima facie* rejection, since the references relied upon by the Examiner in his rejections should be removed by the entering of the Declaration. Accordingly, Appellants respectfully submit that claims 1-26, all the claims presently pending in the application, are clearly patentable and are in condition for allowance.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,

Date: February 28, 2006



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